

Serial No. 10/076,394
November 25, 2003
Reply to the Office Action dated August 25, 2003
Page 4 of 7

REMARKS/ARGUMENTS

Claims 12-19 are pending in this application. The Examiner has withdrawn claims 1-11, 13, 15, and 16. By this Amendment, Applicants AMEND claims 12.

The Examiner indicated that claims 1-11 have been withdraw. However, as argued in the Response to Election Requirement dated February 6, 2003, claims 1-11 were **CANCELED** in the Preliminary Amendment dated February 19, 2002.

Applicants affirm election of embodiment 9, including **Figs. 8 and 9**. The Examiner has alleged that there are no generic claims in the first paragraph on page 2 of the outstanding Office Action. Applicants disagree.

MPEP § 806.04(d) states that a generic claim:

- (a) should read on all the species; AND
- (b) cannot include features not present in each of the added species claims.

By definition, an independent claim is generic to all of its dependent claims. Applicants' claim 12 is clearly generic because (a) claim 12 reads on each of the species indicated by the Examiner; and (b) claim 12 does not include any features not present in each of the species.

Accordingly, Applicants respectfully request that the Examiner rejoin and allow withdrawn claims 13, 15, and 16 when generic claim 12 is allowed.

Claims 12, 14, and 17-19 were rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite. The Examiner has alleged in the fourth paragraph on page 2 of the outstanding Office Action that claim 12 "lacks sufficient structure to support the functional language of 'wherein said internal conductor and said external terminals define a *previously formed, integral, unitary member*'" (emphasis added by Examiner). Applicants respectfully disagree.

The alleged functional language only requires the structure of the internal conductor and external terminals, and only defines the relationship between the internal conductor and external terminals. Thus, Applicants respectfully submit that the structural features of claim 12 support the alleged functional language. Accordingly,

Serial No. 10/076,394
November 25, 2003
Reply to the Office Action dated August 25, 2003
Page 5 of 7

Applicants respectfully request reconsideration and withdrawal of the rejection of claims 12, 14, and 17-19 under 35 U.S.C. § 112, second paragraph.

Claims 12, 14, and 17-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 03-106708 in view of JP 01-253906. Applicants respectfully traverse the rejection of claims 12, 14, and 17-19.

Claim 12 has been amended to recite:

"A bead inductor comprising:
an internal conductor;
a molded member of at least one of a resin material and a rubber material including a powdered magnetic substance with said internal conductor embedded therein; and
external terminals disposed at both ends of said internal conductor and electrically connected thereto; wherein
said internal conductor and said external terminals define a previously formed, integral, unitary member; and
a through-hole for supplying at least one of the resin material and the rubber material in a periphery of the internal conductor in the molded member is formed in at least one of the external terminals.
" (emphasis added)

Applicants' claim 12 recites the feature of "a through-hole for supplying at least one of the resin material and the rubber material in a periphery of the internal conductor in the molded member is formed in at least one of the external terminals." With the improved features of claim 12, Applicants have been able to provide a bead inductor having greatly improved connection reliability between the internal conductor and the external terminals (see, for example, the first full paragraph on page 3 of the originally filed Specification).

Applicants have amended claim 12 to recite the feature of "a through-hole for supplying at least one of the resin material and the rubber material in a periphery of the internal conductor in the molded member is formed in at least one of the external terminals." Neither JP 03-106708 nor JP 01-253906 teaches or suggests this feature.

Serial No. 10/076,394
November 25, 2003
Reply to the Office Action dated August 25, 2003
Page 6 of 7

JP 03-106708 clearly teaches in **Figs. 1-4** that the external terminals **2** and **102** are solid terminals **without any holes**, **NOT** that the external terminals **include through-holes** for supplying at least one resin material and rubber material as recited in Applicants' claim 12.

JP 01-253906 clearly teaches in **Fig. 1** that the external terminals **24** are solid terminals **without any holes**, **NOT** that the external terminals **include through-holes** for supplying at least one resin material and rubber material as recited in Applicants' claim 12.

Thus, Applicants respectfully submit that neither JP 03-106708 nor JP 01-253906 teaches or suggests the feature of "a through-hole for supplying at least one of the resin material and the rubber material in a periphery of the internal conductor in the molded member is formed in at least one of the external terminals" as recited in Applicants' claim 12.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 12 under 35 U.S.C. § 103(a) as being unpatentable over JP 03-106708 in view of JP 01-253906.

Accordingly, Applicants respectfully submit that JP 03-106708 and JP 01-253906, applied alone or in combination, fail to teach or suggest the unique combination and arrangement of elements recited in claim 12 of the present application. Claims 14 and 17-19 depend upon claim 12 and are therefore allowable for at least the reasons that claim 12 is allowable. As noted above, Applicants respectfully request that the Examiner rejoin and allow withdrawn claims 13, 15, and 16 when generic claim 12 is allowed.

In view of the foregoing amendments and remarks, Applicants respectfully submit that this application is in condition for allowance. Favorable consideration and prompt allowance are solicited.

Serial No. 10/076,394
November 25, 2003
Reply to the Office Action dated August 25, 2003
Page 7 of 7

The Commissioner is authorized to charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1353.

Respectfully submitted,

Date: November 25, 2003


Attorneys for Applicants

Joseph R. Keating
Registration No. 37,368

Christopher A. Bennett
Registration No. 46,710

KEATING & BENNETT LLP
10400 Eaton Place, Suite 312
Fairfax, VA 22030
Telephone: (703) 385-5200
Facsimile: (703) 385-5080

10400 Eaton Place
Suite 312
FAIRFAX, VA
Phone: (703) 385-5200
Fax: (703) 385-5080

KEATING & BENNETT LLP

Fax

RECEIVED
CENTRAL FAX CENTER
NOV 25 2003

To: Examiner Nguyen

From: Christopher A. Bennett

Fax: 703-872-9318

Date: November 25, 2003

Phone: 703-308-0821

Pages: 8

Re: 10/076,394

CC:

36856.634

•Comments:

Examiner Nguyen,

Please find attached hereto the following documents for the above-identified application:

Amendment.

Respectfully submitted,



Christopher A. Bennett
for
Keating & Bennett, LLP
(Registration Number 46,710)

OFFICIAL